

## **REMARKS/ARGUMENTS**

Applicant has amended claims 1 and 15 to clarify that the direction of movement corresponds to the combined character and navigation key being moved to a navigation control input position.

Applicant gratefully acknowledges the thorough examination to date and has made an effort to fully respond to all of the issues raised by the Examiner. Applicant has taken care and believes that no new matter has been introduced by way of this response. Reconsideration of the application in view of the foregoing amendments and following remarks is respectfully requested.

### **Claims 1, 2, 4-7 and 21-25**

The Examiner has rejected to claims 1, 2, 4-7 and 21-25 as being obvious and unpatentable over Kocis *et al.* (U.S. Patent No. 5,485,614) in view of Straayer *et al.* (U.S. Patent No. 4,680,577).

Applicant notes at the outset, that in the previous Office Action of November 27, 2007, the Examiner had objected to the same claims and in addition, claims 9-10 and 12-14 as being obvious and unpatentable over Straayer *et al.* in view of Kocis *et al.* In regard to that previous action, Applicant acknowledges a telephone interview initiated by Applicant with the Examiner was conducted on January 31, 2008 in which the Examiner acknowledged Applicant's contention (set out below) that the then primary Straayer *et al.* reference demonstrated no motivation to combine and taught away from the then secondary Kocis *et al.* reference. The parties at that time agreed that a further search would be required before a finding of allowability could be made.

As confirmed by a further telephone discussion with the Examiner on March 17, 2008, it appears that the Examiner has now simply reversed the order of the references and reapplied them. After having agreed that Straayer *et al.* teaches away from Kocis *et*

*al.*, the Applicant is now faced with the allegation that Kocis *et al.*, as a primary reference in view of Straayer *et al.*, as a secondary reference, read on the claims identified.

Applicant submits at the outset, that it knows of no authority for the proposition that, if a primary reference A and a secondary reference B are shown not to have any motivation to combine, as acknowledged by the Examiner herein, there may be nevertheless be a motivation to combine reference B as a primary reference in view of reference A as a secondary reference especially where, as in the present case, the new primary reference B predates new secondary reference A, and new secondary reference A expressly disavows a teaching relied upon in new primary reference B.

This was drawn to the Examiner's attention in the previous Office Action at page 4 and is repeated herein as follows:

"Nevertheless, Applicant draws to the Examiner's attention, the statement at column 1, lines 33-44 of the cited Straayer *et al.* reference, which provides as follows:

"Another prior approach to cursor positioning was to use four of the existing alphanumeric keys as cursor control keys to provide the four directions of cursor movement. To distinguish cursor movement operation of a cursor control key from its normal character entry operation, an additional entry such as the CONTROL key had to be depressed in combination with the cursor control key. While this approach overcame some of the disadvantages of the special function keys, it has been found that operators were slow to learn this approach due to confusion as to which cursor control key provided which cursor movement. [Emphasis added].

Applicant notes that this prior approach, identified in the Straayer *et al.* reference and decried as being unsuitable, is identically the approach disclosed in the cited Kocis *et al.* reference.

To this end, Applicant refers the Examiner to the statement in the *KSR* [*International Co. v. Teleflex Inc.* 82 USPQ (2d), 1385 (2007) at 1395] decision to the effect that:

"When the prior art teaches away from combining certain known elements, discovery of successful means of combining them is more likely to be non-obvious."

In the present Office Action the Examiner has acknowledged that Kocis *et al.* do not disclose a combined character and navigation key being displaceable from an un-depressed position to a plurality of detectable input positions including a character input position corresponding to a character input for a displayable character and at least one navigation control input position corresponding to a navigation control input for movement of a navigation indicator on the display screen but contends that this is disclosed by Straayer *et al.*

The Examiner further contends that it would have been obvious at the time of invention to modify Kocis *et al.* with the teachings of Straayer *et al.*, a combined character and navigation key "because it allows for easier and more accurate control of the cursor." (Examiner's Report page 3)

In the USPTO's published examination guidelines for determining obviousness under 35 USC 103 in view of the *KSR* decision, issued November 6, 2007 (<http://www.USPTO.gov/web/offices/com/sol/og/2007/week45/patguide.htm>), the USPTO has identified that:

"The key to supporting any rejection of 35 USC 103 is a clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court In *KSR* noted that the analysis supporting a rejection under 35 USC should be made explicit. The Court in "*In Re Kahn*" stated that "[R]ejections on obviousness could not be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." (82 USPQ 2d at 1396) [Emphasis added].

Applicant respectfully submits that has not been done in the present instance.

In any event, notwithstanding the foregoing objections, which Applicant maintains, Applicant draws to the Examiner's attention, that the now primary Kocis *et al.* reference teaches two very clear aspects of the environment of that invention. First, the Kocis *et al.* invention is directed to a pointing device for a very small portable personal computer system (see column 1, line 45, 49-50; column 3, lines 7 and 8; and column 6, lines 13-15). Second, the Kocis *et al.* reference clearly indicates that the pointing device disclosed therein is to "be added to most portable computer systems by making only two alterations in the system design: 1) additions must be made to the keyboard controller micro code, and 2) a pointing device interrupt output must be added to the keyboard controller." (Column 7, lines 43-49) [Emphasis added].

It is submitted that neither of these requirements, clearly set out in Kocis *et al.*, is met by the combined character and navigation key disclosed in the Straayer *et al.* reference.

With regard to the small size of the keyboard in particular, attention is drawn to Figures 1 and 2 of the Straayer *et al.* reference, in which additional hardware features are required to implement switches and or sensors on all four sides of the key in order to provide the pointing capability. Applicant submits that these features, which include in the embodiment of Figure 1, sensors or strain gauges (26, 28, 34 and 36) and in the embodiment of Figure 2, sensors (64 and 66), would be difficult to introduce into a small form factor keyboard especially one intended for a notebook or other portable computing device, in which the keyboard is smaller than normal, as taught in Kocis *et al.* Furthermore, as shown in both Figures 1 and 2, each of the sensors is accompanied by a wire (in Figure 1, wires 28, 30, 38 and 40 and in the case of Figure 2, wires 68 and 70), which must be connected as shown in Figure 3 to a signal conditioning circuit and then to the CPU. These additional wires will also occupy space, which is at a

premium, and manifestly not available in a notebook computer-sized keyboard.

With regard to the second differentiating factor, Figure 3 demonstrates that the key switch sensors follow a different path to the CPU than the keyboard. As such, they do not fall within the limitation imposed in the Kocis *et al.* reference that the only modifications to the computer system be additions to the computer keyboard controller microcode and the addition of a pointing device Interrupt output. Instead, key switch sensor signal conditioning software would have to be added and software added to the CPU which is expressly differentiated from the keyboard software already in place, and constitutes a much more invasive and less transparent alteration to the existing system.

For all of the foregoing reasons, Applicant respectfully submits that, rather than the vague and unarticulated basis for motivation to combine proffered by the Examiner, Applicant has pointed out that a person of ordinary skill in the art, presented with the Kocis *et al.* reference, would not have been motivated to combine it with the methodology taught in the Straayer *et al.* reference, because of the additional complexity and lack of transparency in the operating system software and the additional components, which would cause difficulty in the cramped quarters of a notebook-sized keyboard.

Accordingly, Applicant respectfully submits that the objection of the Examiner has been traversed.

In any event, Applicant has amended claim 1 to clarify that the processor is programmed for causing the navigation indicator on the display screen to move in a direction corresponding to the combined character and navigation key being moved to a corresponding one of the at least one navigation control input positions when the combined character and navigation key is in such navigation control input position while the command input signal is simultaneously received from the command key.

Because the objected-to claims 2, 4-7 and 21-25 are all ultimately dependent from a now-allowable base claim (independent claim 1), Applicant submits that the objection to these claims is also respectfully traversed.

Further, Applicant repeats and relies on its submissions and previous Office Actions with regard to its contention that *Straayer et al.* do not in any event disclose that the character or navigation key is a spacebar key and that the displayable character is a space character as claimed in to dependent claim 2 herein.

### **Claims 3, 9-10 and 12-14**

The Examiner has objected to claims 3, 9-10 and 12-14 as being obvious and unpatentable over *Kocis et al.* in view of *Straayer et al.* and further, in view of *Osawa et al.* (U.S. Patent No. 2001/0033270).

Applicant repeats and relies upon its submissions set out above and in previous Office Actions, to the effect that there is no need, much less any motivation, to combine the cited *Kocis et al.* reference and with the cited *Straayer et al.* reference, irrespective of the order in which they are presented.

Furthermore, Applicant submits that *Osawa et al.* do not even contemplate a character insertion mode, as distinguished from a display navigation movement mode by the inculcation of a second command key, whether or not simultaneously depressed as claimed herein. Accordingly, Applicant submits that there is no motivation to combine the cited *Osawa et al.* reference with any of *Straayer et al.* or *Kocis et al.*

Further, in any event, Applicant repeats and relies upon its submissions in previous Office Actions to the effect that the Examiner lacks the requisite motivation to combine the *Straayer et al.* and *Osawa et al.* references on the basis that *Straayer et al.* is

directed to a desktop keyboard, which is sufficiently large that the index fingers of the user may rest in the home position above the designated F character key throughout the course of user's interaction with the keyboard (in this regard, the Examiner has referred to column 1, lines 28-32 thereof, to the effect that it is not advantageous to have the operator move his fingers from the home position, and column 5, lines 21-26 of the cited reference in which it is indicated that it is advantageous for the user to maintain its index fingers a large percentage of time above the F character key).

By way of contrast, in Osawa *et al.*, the invention is directed to a key input device for a portable telephone, which, as shown in the various views of Figure 3 thereof, is configured so that key input, including that of the multi-position switch, is presumably effected by intermittently positioning a finger, typically the thumb, over each input key as needed, but in the ordinary course of operation of the device, the user's fingers would not linger over any of the input keys thereof.

Furthermore, in respect of claim 13, the Examiner contends that, notwithstanding his acknowledgement that Osawa *et al.* do not disclose the other switches as being non-dome contact switches, this would be a designer's choice. Applicant notes that it has specifically taught on the present application, at paragraph 41 thereof, a number of embodiments in which one is the use of dome switches for all of the contact switches. Accordingly, the restriction in claim 13 in that the new embodiments in which the first and second switches are non-dome contact switches constitutes a constitute and inventive feature which, it is respectfully submitted, the Examiner cannot blithely explain away on the basis of obviousness as being a matter of "design choice", when the cited Osawa *et al.* reference has absolutely no indication of this possibility.

In any event, inasmuch as all of these claims are dependent from a now-allowable base claim, Applicant submits that the Examiner's objection has been traversed.

### **Claim 8**

The Examiner has objected to claim 8 as being obvious and unpatentable over Kocis *et al.* in view of Straayer *et al.* in view of Osawa *et al.* in further view of Lee *et al.* (U.S. Publication No. 2002/019957).

Applicant repeats and relies upon its submissions set out above and in previous Office Actions to the effect that there is no motivation to combine the cited Kocis *et al.*, Straayer *et al.* and Osawa *et al.* references, irrespective of the order in which they are presented.

With respect to claim 8, the Examiner has acknowledged that Kocis *et al.*, Straayer *et al.* and Osawa *et al.* do not disclose an electronic hand held device wherein the display screen is mounted within the face but contends that Lee *et al.* disclose a handheld device with a display screen being mounted within the face, citing as an example, Figure 1 and case 13 disclosed therein. Applicant respectfully disagrees with the contention of the Examiner.

The reference numeral 13 in the Lee *et al.* reference, as submitted in Applicant's earlier responses to various Office Actions is directed, not to a face, but rather to a case of a handheld device. As is taught in the Lee *et al.* reference, and as is shown in Figure 2 thereof, in fact, the keyboard is not mounted in the face in which the display screen is mounted, namely the front face of the case 13, but rather through a connector in an adjacent face namely the bottom face of the case 13, as shown in paragraph 26 thereof, in which the connector 16 is provided "at a lower end portion" of the PDA 10.

In any event, inasmuch as claim 8 is ultimately dependent from a now-allowable base claim (Independent claim 1), Applicant respectfully submits that the Examiner's objection has been traversed.



### **Claims 15-17 and 26**

The Examiner has objected to claim 15-17 and 26 as being obvious and unpatentable over Lee *et al.* in view of Kocis *et al.* in further view of Straayer *et al.*

Applicant repeats and relies upon the submissions, set out above, and in earlier responses to Office Actions, to the effect that there is no motivation to combine the cited Kocis *et al.* and Straayer *et al.* references, irrespective of the order in which they are presented.

Furthermore, neither Lee *et al.* nor Straayer *et al.* teach or suggest the simultaneous depressing of a commercial key and the space bar key or indeed any other single character and navigation key in a navigation control input position as now called for by independent claim 15.

Accordingly, Applicant further submits that there is no motivation to combine the cited Lee *et al.* reference with either of the Kocis *et al.* or Straayer *et al.* references.

In any event, Applicant has amended claim 15 in a manner similar to that of claim 1, set out above.

Inasmuch as claim 16-17 and 26 are ultimately dependent from a now-allowable base claim (independent claim 15), Applicant respectfully submits that the Examiner's rejections have been traversed.

### **Claims 18-20**

The Examiner has objected to claims 18-20 as being obvious and unpatentable over Lee *et al.* in view of Kocis *et al.* in view of Straayer *et al.* and in further view of Osawa *et al.*

Applicant repeats and relies on its submissions, set out above, and in earlier responses to various Office Actions, to the effect that there is no motivation to combine the cited Kocis *et al.*, Straayer *et al.* and Osawa *et al.* references, irrespective of the order in which they are presented.

As set out in Applicant's earlier responses to various Office Actions, Lee *et al.* is directed to a personal digital assistant (PDA) having a touch screen 14. There is no indication that the PDA has any form whatsoever of cursor control. The need for any such cursor control would be obviated by the touch screen nature of the display 14, which would permit the user to position the cursor anywhere through the display by simply tapping at the desired location on the screen. Moreover, inasmuch as Lee *et al.* discloses a portable keyboard, whose objective is to dispense with a symbol region so as to increase the effective display area of the PDA as taught in paragraph 24 thereof, there would be no motivation to create a redundant system.

Further, Lee *et al.* teach at paragraph 6 thereof, that it would be disadvantageous to have a keyboard of any significant size. Accordingly, there would be no motivation to combine the compact keyboard of Lee *et al.* with any features that would increase the size of the keyboard solely for the purpose of providing such redundant capability.

Moreover, Applicant takes issue with the contention of the Examiner at page 18 of the present Office Action to the effect that there would be a motivation to combine Lee *et al.* with the teachings of Kocis *et al.* and Straayer *et al.* because the incorporation of the command key and multi-purpose key switch of Straayer *et al.* and the keyboard of Lee *et al.* would allow for redundant cursor movement and act as a failsafe in case one of the cursor movement systems fails to operate, and to prevent accidental movements of the cursor.

In this regard, Applicant notes that Lee *et al.* is directed to a personal digital assistant (PDA) having a touch screen 14. There is no indication that the PDA has any form

whatsoever of cursor control. The need for any such cursor control would be obviated by the touch screen nature of the display 14, which would permit the user to position the cursor anywhere throughout the display simply by tapping at the desired location of the screen. Moreover, inasmuch as Lee *et al.* disclose a portable keyboard, whose objective is to dispense with symbol regions so as to increase the effective display area of the PDA, as taught in paragraph 24 thereof, there would be no motivation to create a redundant system.

Finally, Lee *et al.* teach at paragraph 6 thereof, that it would be disadvantageous to have a keyboard of any significant size. Accordingly, there would be no motivation to combine the compact keyboard of Lee *et al.* with any features that would increase the size of the keyboard, solely for the purpose of providing such redundant capability.

In any event, inasmuch as these claims are ultimately dependent from a now-allowable base claim, Applicant submits that the Examiner's objection has been traversed.

### **Conclusion**

Applicant respectfully submits that all of the outstanding objections have been overcome by way of argument. Applicant believes that no new matter has been entered during this process. Applicant respectfully submits that all of the claims presently standing in the application are patentably distinguished from all of the references of record, either taken alone or in any combination. Accordingly, reconsideration and allowance of this application is respectfully solicited.

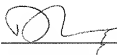
These remarks are filed in response to the Examiner's Report of March 5, 2008, a response to which is due by June 5, 2008 to avoid the payment of extension of time fees. Accordingly, Applicant respectfully submits that no extension of time fees fall due in connection with the filing of this response. If Applicant is mistaken, the

Commissioner is hereby authorized to deduct any necessary fees from our Deposit Account No. 13-2400.

Should the Examiner believe, however, that additional amendments to the claims may be required to secure allowance of this application, he is invited to telephone the undersigned at the below-noted number to facilitate further prosecution of this application.

Respectfully Submitted,  
PLETIKOSA, Velimir et al

By:



Dennis S. K. Leung, Regn. No.47,325

Place: Ottawa, Ontario, Canada  
Date: May 15, 2008  
Tele No.: 613-9077149